

REMARKS

The Examiner has indicated that the Amendment submitted with the filing of the RCE in this case was non-compliant for failing to include appropriate amendment markings in the claims, e.g., bracketing and underlining. Applicant submits that the form of the claim amendments is correct pursuant to the rules of the Patent Office.

All of the claims currently pending in the case are new claims, i.e., claims which were not contained in the issued patent. The proper manner for adding new claims to a reissue application is to underline each word of the claim. This is required because the amendments to a reissue application must be made in comparison to the patent as issued, and anything new must be underlined.

When amendments are made to such new claims, the situation is different than for an original application. In the typical case, the new claims would not be underlined, but amendments to those claims would be shown by underlining the added text and putting the deleted text in brackets. The MPEP makes it clear, however, that this is not the proper manner of amending new claims in a reissue application. This is again because all changes to a reissue application must be made in comparison to the issued patent. It would not be appropriate, for example, to put deleted text from a new claim in brackets, because that deleted text did not appear in the original patent.

However, because all wording of a new claim in a reissue application must be underlined, it is not apparent where changes are made when such a new claim is amended during prosecution. The MPEP therefore provides that the applicant must indicate the amendments in the response, at a location other than within the claims themselves.

Applicant therefore included a table in the response which identified the nature of amendments made to the pending claims.

The foregoing provisions are set forth and explained in the MPEP at section 1453, and particularly subsection V.D., reproduced below. For the examiner's convenience, the entirety of section 1453 of the MPEP is attached hereto.

An amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue are made *vis-à-vis* the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed in the "Remarks" portion of the amendment. Also, per 37 CFR 1.173(c), each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

For the foregoing reasons, applicant submits that the prior amendment in this application is in appropriate format, and applicant requests withdrawal of the Notice of Non-Compliant Amendment.

Respectfully submitted,

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1453 Amendments to Reissue Applications [R-5] - 1400 Correction of Patents

1453 Amendments to Reissue Applications [R-5]

37 CFR 1.121 Manner of making amendments in application.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

37 CFR 1.173 Reissue specification, drawings, and amendments.

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent

claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

The provisions of 37 CFR 1.173(b)-(g) and those of 37 CFR 1.121(i) apply to amendments in reissue applications. Any amendments submitted in a reissue application **must** comply with 37 CFR 1.173(b).

Amendments submitted in a reissue application, including preliminary amendments (i.e., amendments filed as a separate paper to accompany the filing of a reissue application), must comply with the practice outlined below in this section; however, for examiner's amendments to the specification and claims, 37 CFR 1.121(g) provides certain exceptions to that practice in the interest of expediting prosecution. The exceptions set forth in 37 CFR 1.121(g) also apply in reissue applications.

Pursuant to 37 CFR 1.173(a), no amendment in a reissue application may enlarge the scope of the claims, unless "applied for within two years from the grant of the original patent." Further, the amendment may not introduce new matter. See MPEP § 1412.03 for further discussion as to the time limitation on enlarging the scope of the patent claims in a reissue application.

All amendment changes must be made relative to the patent to be reissued. Pursuant to 37 CFR 1.173(d), any such changes which are made to the specification, including the claims, must be shown by employing the following "**markings**:"

(A) The matter to be omitted by reissue must be enclosed in brackets; and

(B) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (pursuant to 37 CFR 1.96 for computer printouts or programs, and 37 CFR 1.825 for sequence listings). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

I. THE SPECIFICATION

37 CFR 1.173(b)(1) relates to the manner of making amendments to the specification other than the claims. It is not to be used for making amendments to the claims or the drawings.

All amendments which include any deletions or additions must be made by submission of the entire text of each added or rewritten paragraph with markings (as defined above), except that an entire paragraph of specification text may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. Applicant must indicate the precise point where each amendment is made. All bracketing and underlining is made in comparison to the original patent, not in comparison to any prior amendment in the reissue application. Thus, all paragraphs which are newly *added* to the specification of the original patent must be submitted as completely underlined each time they are re-submitted in the reissue application.

II. THE CLAIMS

37 CFR 1.173(b)(2) relates to the manner of making amendments to the claims in reissue applications. It is not to be used for making amendments to the remainder of the specification or to the drawings. 37 CFR 1.173(b)(2) requires that:

(A) For each claim that is being amended *by the amendment being submitted* (the current amendment), the entire text of the claim must be presented with markings as defined above;

(B) For each new claim added to the reissue *by the amendment being submitted* (the current amendment), the entire text of the added claim must be presented completely underlined;

(C) A patent claim should be canceled by a direction to cancel that claim, there is no need to present the patent claim surrounded by brackets; and

(D) A new claim (previously added in the reissue) should be canceled by a direction to cancel that claim.

Original patent claims are never to be renumbered; see 37 CFR 1.173(e). A patent claim retains its number even if it is canceled in the reissue proceeding, and the numbering of any added claims must begin after the last original patent claim.

Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is pending or canceled. The failure to submit the claim status will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

Also pursuant to 37 CFR 1.173(c), each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for all changes made in the claim(s), whether insertions or deletions). The failure to submit an explanation will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

III. THE DRAWINGS

37 CFR 1.173(a)(2) states that amendments to the original patent drawings are not permitted, and that any change to the drawings must be by way of 37 CFR 1.173(b)(3). See MPEP § 1413 for the manner of making amendments to the drawings in a reissue application.

Form paragraph 14.20.01 may be used to advise applicant of the proper manner of making amendments in a reissue application.

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¶ 14.20.01 Amendments To Reissue-37 CFR 1.173(b)

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b). In addition, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See MPEP § 1414.01.

Examiner Note

This form paragraph may be used in the first Office action to advise applicant of the proper manner of making amendments, and to notify applicant of the need to file a supplemental oath/declaration before the application can be allowed.

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Form paragraph 14.21.01 may be used to notify applicant that proposed amendments **filed prior to final rejection** in the reissue application do not comply with 37 CFR 1.173(b).

¶ 14.21.01 Improper Amendment To Reissue - 37 CFR 1.173(b)

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

A shortened statutory period for reply to this letter is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note

1. This form paragraph may be used for any 37 CFR 1.173(b) informality as to an amendment submitted in a reissue application prior to final rejection. After final rejection, applicant should be informed that the amendment will not be entered by way of an Advisory Office action.

2. In bracket 2, specify the proposed amendments that are not in compliance.

Note that if an informal amendment is submitted **after final rejection**, form paragraph 14.21.01 should not be used. Rather, an advisory Office action should be issued using Form PTO-303 indicating that the amendment was not entered because it does not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications.

IV. ALL CHANGES ARE MADE *VIS-À-VIS* THE PATENT TO BE REISSUED

When a reissue patent is printed, all underlined matter is printed in *italics* and all brackets are printed as inserted in the application, in order to show exactly which additions and deletions have been made to the patent being reissued. Therefore, all underlining and bracketing in the reissue application should be made relative to the text of the patent, as follows. In accordance with 37 CFR 1.173(g), all amendments in the reissue application must be made relative to (i.e., *vis-à-vis*) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. If there was a prior change to the patent (made via a prior concluded reexamination certificate, reissue of the patent, certificate of correction, etc.), the first amendment of the subject reissue application must be made relative to the patent specification as changed by the prior proceeding or other mechanism for changing the patent. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment.

The Subject Patent Already Has Underlining or Bracketing

If the original (or previously changed) patent includes a formula or equation already having underlining or bracketing therein as part of the formula or equation, any amendment of such formula or equation should be made by bracketing the entire formula and rewriting and totally underlining the amended formula in the re-presented paragraph of the specification or rewritten claim in which the changed formula or equation appears. Amendments of segments of a formula or equation should not be made. If the original patent includes bracketing and underlining from an earlier reexamination or reissue, double brackets and double underlining should be used in the subject reissue application to identify and distinguish the present changes being made. The subject reissue, when printed, would include double brackets (indicating deletions made in the subject reissue) and boldface type (indicating material added in the subject reissue).

V. EXAMPLES OF PROPER AMENDMENTS

A substantial number of problems arise in the Office because of improper submission of amendments in reissue applications. The following examples are provided to assist in preparation of proper amendments to reissue applications.

A. *Original Patent Description or Patent Claim Amended*

Example (1)

If it is desired to change the specification at column 4 line 23, to replace "is" with --are--, submit a copy of the entire paragraph of specification of the patent being amended with underlining and bracketing, and point out where the paragraph is located, e.g.,

Replace the paragraph beginning at column 4, line 23 with the following:

Scanning [is] are controlled by clocks which are, in turn, controlled from the display tube line synchronization. The signals resulting from scanning the scope of the character are delivered in parallel, then converted into serial mode through a shift register wherein the shift signal frequency is controlled by a clock that is, in turn, controlled from the display tube line synchronization.

Example (2)

For changes to the claims, one must submit a copy of the entire patent claim with the amendments shown by underlining and bracketing, e.g.,

Amend claim 6 as follows:

Claim 6 (Amended). The apparatus of claim [5] 1 wherein the [first] second piezoelectric element is parallel to the [second] third piezoelectric element.

If the dependency of any original patent claim is to be changed by amendment, it is proper to make that original patent claim dependent upon a later filed higher numbered claim.

B. *Cancellation of Claim(s)*

Example (3)

To cancel an original patent claim, in writing, direct cancellation of the patent claim, e.g.,

Cancel claim 6.

Example (4)

To cancel a new claim (previously added in the reissue), in writing, direct cancellation of the new claim, e.g.,

Cancel claim 15.

C. Presentation of New Claims

Example (5)

Each new claim (i.e., a claim not found in the patent, that is newly presented in the reissue application) should be presented with underlining throughout the claim, e.g.,

Add claim 7 as follows:

Claim 7. The apparatus of claim 5 further comprising electrodes attaching to said opposite faces of the first and second piezoelectric elements.

Even though original claims may have been canceled, the numbering of the original claims does not change. Accordingly, any added claims are numbered beginning with the number next higher than the number of claims in the original patent. If new claims have been added to the reissue application which are later canceled prior to issuance of the reissue patent, the examiner will renumber any remaining new claims in numerical order to follow the number of claims in the original patent.

D. Amendment of New Claims

An amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue are made *vis-à-vis* the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed in the "Remarks" portion of the amendment. Also, per **37 CFR 1.173(c)**, each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

E. Amendment of Original Patent Claims More Than Once

The following illustrates proper claim amendment of original patent claims in reissue applications:

A. Patent claim.

Claim 1. A cutting means having a handle portion and a blade portion.

B. Proper first amendment format.

Claim 1 (Amended). A [cutting means] knife having a bone handle portion and a notched blade portion.

C. Proper second amendment format.

Claim 1 (Twice Amended). A [cutting means] knife having a handle portion and a serrated blade portion.

Note that the second amendment must include the changes previously presented in the first amendment, i.e., [cutting means] knife, as well as the new changes presented in the second amendment, i.e., serrated.

The word bone was presented in the first amendment and is now to be deleted in the second amendment. The word "bone" is NOT to be shown in brackets in the second amendment. Rather, the word "bone" is simply omitted from the claim, since "bone" never appeared in the patent. An explanation of the deletion should appear in the remarks.

The word notched which was presented in the first amendment is replaced by the word serrated in the second amendment. The word notched is being deleted in the second amendment and did not appear in the patent; accordingly, "notched" is not shown in any form in the claim. The word serrated is being added in the second amendment, and accordingly "serrated" is added to the claim and is underlined.

In the second amendment, the deletions of "notched" and "bone" are not changes from the original patent claim text and therefore are not shown in brackets in the second amendment. In both the first and the second amendments, the entire claim is presented only with the changes from the original patent text.

VI. ADDITIONAL EXAMPLES

(A) For a reissue application, where the patent was previously reissued: As per MPEP § 1411, double underlining and double bracketing are used in the second reissue application to show amendments made relative to the first reissued patent

(B) For a reissue application, where the patent was previously reexamined and a reexamination certificate has issued for the patent: An amendment in the reissue application must be presented as if the changes made to the original patent text via the reexamination certificate are a part of the original patent. Thus, all italicized text of the reexamination certificate is presented in the amendment (made in the reissue application) without italics. Further, any text found in brackets in the reexamination certificate is omitted in the amendment (made in the reissue application).

(C) For a reissue application, where a certificate of correction has issued for the patent: An amendment in the reissue application must be presented as if the changes made to the original patent text via the certificate of correction are a part of the original patent. Thus, all text added by certificate of correction is presented in the amendment (made in the reissue application) without italics. Further, any text deleted by certificate of correction is entirely omitted in the amendment (made in the reissue application).

(D) For a reissue application, where a statutory disclaimer has issued for the patent: Any claim statutorily disclaimed is no longer in the patent, and such a claim cannot be

amended. The statutorily disclaimed claim(s) should be lined through, and not surrounded by brackets.

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